

REMARKS

This Amendment and Response is submitted with a Request for Continued Examination under 37 C.F.R. 1.114, and is intended to fully respond to the Final Office Action mailed October 20, 2005, as well as the Advisory Action mailed January 18, 2006. In the Final Office Action, claims 33-64 were examined, and all claims were rejected. More specifically, claims 33-62, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505); and claim 63 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Reconsideration of these rejections is respectfully requested.

In this Response, no claims have been added, amended or canceled, and thus claims 33-64 remain pending in the application.

I. Although Not Prior Art At This Time, Eftekhari Will Be Distinguished

The previous after-final response explained in detail why the cited Eftekhari publication (U.S. Publ. No. 2002/0024505) could not be considered prior art. Specifically, MPEP § 2136.03 and the Wertheim decision cited therein (646, F.2d 527, 209 U.S.P.Q. 554 (C.C.P.A. 1981)), clarify that Eftekhari could only be granted the effective priority date of the parent application if Eftekhari included **issued claims** that are fully supported by the disclosure of the abandoned parent application. At this stage, Eftekhari is still being prosecuted before the PTO and thus has no “issued claims.” In the future, if Eftekhari should go abandoned, or issue with claims that are not supported by the parent application, it will be clear that the Eftekhari patent (and hence the published application) cannot be used as a prior art reference as of the date of the abandoned parent application. Indeed, a review of the claims included within the published Eftekhari application (against the abandoned parent application provided by the Examiner) clearly shows that the published claims all rely on the newly added material in the CIP application.

However, Applicant acknowledges that it is possible for the Eftekhari CIP application to ultimately issue with claims that are supported by the parent application (a scan of PAIR shows that claim amendments have been made since the publication of the Eftekhari application). Thus, in order to expedite prosecution of the present case, Applicant has elected to distinguish

the disclosure of the Eftekhari parent application from the pending claims, as described in detail below. This election to proceed via an RCE as opposed to appealing the Examiner's characterization of Eftekhari as prior art should not be viewed as a waiver of Applicant's rights to challenge the prior art nature of any patent which ultimately issues from the Eftekhari application.

II. Claim Rejections – 35 U.S.C. § 103

Claims 33-62, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505). Claim 63 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Applicant respectfully traverses the § 103 rejections, as the Examiner has failed to establish a prima facie case of obviousness. In order to establish a prima facie case, the references must show that the cited references teach or suggest each of the elements of the claimed invention (MPEP § 706.02(j) and 2142-43). With respect to the cited references, all elements of the pending claims are neither taught nor suggested.

Independent claim 33

Beaton relates to a system for graphical navigation within electronic devices and has been described in detail in prior responses. The Final Office Action noted that Beaton provides "an input element on the housing where the input element was separate from the display," and cited the navigational control on the keypad 330 in Fig. 3 as an example of such an input element. (Final Office Action at p. 2.) The Final Office Action further noted that Beaton includes a control image in the background of the display (citing Fig. 8), but admitted that Beaton did not teach associating the background control image with the input element so that activation of the input element initiates performance of the task indicated by the background control image. (Final Office Action at p. 3.) For this missing teaching, the Examiner allegedly relies on paragraph 0017 of the Eftekhari publication (which paragraph is also included in the abandoned Eftekhari parent application).

As noted in prior responses, the Beaton reference relies on a touch screen display where a user presses the background control image in order to initiate a corresponding action, such as a

scrolling of the text displayed in the foreground. Indeed, the sentence prior to the portion cited by the Examiner clearly states that the “user may activate the navigation tool by touching and holding the center of the navigation tool for a predetermined time period, for example, one to two seconds (Fig. 7B).” Col. 5, lines 16-19. Thus, while Beaton does display a conventional set of navigation buttons in Fig. 3A, it is beyond question that these buttons are not used for manipulating information in the background of the touch screen display. Rather, it is apparent from a complete reading of the patent that Beaton only describes the use of a touch screen in order to interact with the background control images. Thus, the Final Office Action relies completely on Eftekhari to supply the missing teachings of associating a background control image with an “input element” on the housing of an electronic device.

Eftekhari teaches the use of color-coordinated links (e.g., hyperlinks on a Web page) on a small display (such as that used on a mobile phone) to allow a user to quickly recognize the link between a button on the keypad and the link on the display and then select that link with a single keystroke. See p. 4 of the Eftekhari parent application.

Eftekhari does not teach or suggest the use of background control images in addition to the more conventional foreground information (such as the color-coded hyperlinks). Thus, Eftekhari was simply cited for its inclusion of the color-coded links between foreground information displayed on the screen and lighted keys found on the keypad. However, this feature of the Eftekhari application does not supply the missing elements of the Beaton patent. This is apparent from the fact that even if Beaton and Eftekhari were combined as suggested by the Examiner, the combination would utilize color-coded links for selecting foreground information and the Beaton touch screen for activating the background control images. Specifically, the color-coding feature of Eftekhari could not be applied to the background control images described in Beaton and recited in pending claim 33. Indeed, as noted in the specification of the present application, the background control images are presented as overlapping images (e.g., as watermarks), and therefore may be visible on any type of display including a monochromatic or “gray scale” display. In this manner, different colors applied to the background control images would not be readily apparent to the end user, and thus color-coding the background images to match different input keys would simply not work. Indeed, there is no teaching or suggestion within either Beaton or Eftekhari to employ different colors to differentiate the various

background control images (and hence associate such images with different input elements on the housing).

Thus, both Beaton and Eftekhari fail to suggest the invention recited in pending claim 33. Specifically, Beaton only teaches the use of a touch screen to manipulate background control images, while Eftekhari merely teaches the use of color-coded input keys to activate different links contained within the foreground of the display. There is simply no suggestion within the cited references to associate a background control image with an input element that is found on the housing of the electronic device and that is not part of the display itself (i.e., where the input element is not a touch screen).

Indeed, both Beaton and Eftekhari actually **teach away** from the pending claims. In particular, Beaton teaches the use of a touch screen as opposed to attempting to associate a background control image with an input element, while Eftekhari teaches that a large number of color-coded keys (e.g., 12 keys on a conventional telephone keypad) provide more options than would otherwise be available with a limited number of soft-keys. See the description of ATM-style “soft-keys” at pp. 1-2 of the Eftekhari parent application, as well as the “Summary of the Invention” on p. 4 (fourth paragraph) which notes that a further advantage of the invention is that “the display, though it may be too full of links to see a positional correlation with nearby buttons, is still close enough to the buttons, that the button colors may be seen with peripheral vision.” Thus, Eftekhari states that the color-coded buttons are used in place of soft-key buttons that rely on positional correlation with elements in the display.

In sum, neither of the cited references, either alone or in combination, teach the invention of independent claim 33. Specifically, the step of “associating the [background] control image with the input element” is not suggested by Beaton (which relies on a touch screen rather than a separate “input element” to activate the background control image) or Eftekhari (which merely describes the use of color-coded buttons to activate links shown in the **foreground** of the display, and which specifically distinguishes the use of “soft-keys” that rely on positional correlation with the information on the display). In light of the above remarks, reconsideration of the § 103(a) rejection of claim 33 is respectfully requested.

Dependent claims 34-42

While dependent claims 34-42 depend from independent claim 33 and are therefore believed to be allowable for the reasons noted above, Applicant additionally responds to several of the arguments made in the Final Office Action relative to the dependent claims. In particular, with respect to claim 34, the Final Office Action notes (at p. 3) that Beaton further teaches “positioning the control image in the background of the display proximate to the input element” and cites Figs. 3A and 10A-10C for this alleged teaching. However, the cited figures do not teach such positional correlation. Rather, Fig. 3A shows a conventional navigational array that is not proximate to the control image (and which is merely used for controlling the “foreground” information displayed on the screen). Similarly, Figs. 10A-10C illustrate a user operating the background control image by pressing the **touch screen** as opposed to activating a proximate “input element on the housing wherein the input element is separate from the display.” Thus, the additional limitation of claim 34 is not taught by the touch screen of Beaton, nor is it suggested by the conventional keypad 330 which is neither used to activate the background control image nor positioned “proximate” to the control image.

Dependent claim 35 further recites the inclusion of a plurality of control images and input elements, as well as the association of each of the background images with one of the input elements. The Examiner again cites the keypad 330 of Beaton together with the touch screen display of Fig. 9 to allegedly show this feature. However, as summarized above, the keypad 330 is not suggested for use with the background control images in Beaton. Furthermore, the use of a single touch screen teaches away from the use of “a plurality of input elements.” While Eftekhari does teach the use of multiple keys for activating different hyperlinks on the display, Eftekhari does not suggest associating such keys with different background control images (as described above). Thus, dependent claim 35 is further believed to be allowable over the cited references.

Like dependent claim 34 above, dependent claim 36 further recites that the plurality of background control images are each positioned proximate to one of the input elements. Neither Beaton nor Eftekhari teach this element (i.e., Beaton teaches use of a touch screen, while Eftekhari teaches the use of color-coded keys so that a large number of keys within the peripheral vision of the user may be utilized as opposed to positional correlation of each image with nearby soft-keys).

Dependent claims 37 and 38 recite the use of defined regions within the display so that each of the background control images can be placed within one of the regions, wherein one of the input elements is positioned proximate to each of the defined regions. Although p. 4 of the Final Office Action cites portions of the Beaton patent that allegedly show the use of “defined regions,” these cited portions do not disclose or suggest the use of such defined regions. Indeed, due to the disclosed use of a touch screen as opposed to soft-keys or “input elements” that must be located near the control image, there is simply no suggestion within Beaton to utilize defined regions for each of the images (where one of the input elements is located adjacent to each region). Therefore, in addition to the reasons noted above for independent claim 33, Applicant further requests reconsideration of the obviousness rejections of dependent claims 37 and 38.

Dependent claims 39 and 40 recite that the input elements comprise buttons (claim 39) and that the electronic device further comprises a watch (claim 40). The Final Office Action notes that the Beaton device includes buttons within the keypad 330 and that the same device includes a clock generator. However, as described in greater detail above, the buttons shown in the keypad 330 are not used to manipulate the background control images (these are manipulated by the touch screen) and thus do not coincide with the recited “input elements.” Due to Beaton’s use of a touch screen, there is simply no teaching or suggestion to use buttons as “input elements.” Additionally, while the Beaton device does include a clock generator, the cited portion of the Beaton patent (col., 4, lines 10-14) does not disclose or suggest using the device as a “watch” as that term was defined and shown in the present application (e.g., as shown in Figs. 3A-3C).

Finally, dependent claim 41 recites that the input element provides for movement in at least two directions (i.e., is one of a joystick, a rocker switch, a rotary dial, or a slide bar), wherein each of the background control images is associated with a different directional movement of the input element. The Final Office Action cites the Beaton patent at col. 1, lines 56-64 for allegedly showing such a multi-directional input element. However, the cited portion of Beaton only describes **graphical on-screen controls** such as arrows or scroll bars that are **used as substitutes for hard-keys**. Furthermore, the cited portion of Beaton only constitutes background disclosure relative to the invention of Beaton (i.e., the use of a touch screen to activate background control images). Thus, Beaton does not teach or suggest the recited multi-directional input element (e.g., a joystick, rocker switch, etc.) that allows a user to select one of a

plurality of background control images. Similarly, claim 42 depends from claim 41 and further recites the inclusion of defined regions containing each of the control images. Claim 42 is thus allowable for the reasons detailed above with respect to independent claim 33 and dependent claim 37.

Claims 43-64

Additional claim sets 43-54 and 55-64 are believed to be allowable for the reasons noted above with respect to the claims 33-42. Namely, each of the independent claims 43 and 55 include the requirement of associating a background control image with an input element and, as described in detail above, the cited references (even when taken in combination) fail to disclose or teach this invention. Indeed, Beaton teaches away from such association by utilizing a touch screen in lieu of any soft-keys or “input elements.” Additionally, while Eftekhari discloses the use of color-coded keys on the keypad of a mobile phone to activate links on a display, it is apparent that such links are only found in the foreground of the display and that the system of Eftekhari would not be useful for activating background images (i.e., images which are presented in the form of a watermark and that may be displayed on a monochrome screen).

No Prima Facie Case of Obviousness

In summary, the combination of Beaton and Eftekhari as proposed in the Final Office Action does not create a prima facie case of obviousness. First, the purported combination of the two references does not include each of the recited elements of the independent claims (i.e., there is no disclosure of associating input elements on the housing of the device with **background control images** on the display). Secondly, there is simply no suggestion in either of the references to make such a combination. Rather, Beaton’s use of a touch screen display to activate the control images **teaches away** from the use of soft-keys as disclosed in Eftekhari. Similarly, Eftekhari itself teaches away from the present invention by specifically distinguishing the use of positional soft-keys (which are inherently limited in the number of such available keys), opting instead for a larger number of color-coded keys that may be seen within a user’s peripheral vision when looking at the display (see the Eftekhari parent application at pp. 1, 4 and

9). Therefore, reconsideration of the § 103(a) rejections of all the pending claims is respectfully requested.

Since the remarks above are believed to distinguish over the applied reference, any remaining arguments supporting the claim rejections are not acquiesced to because they are not addressed herein.

Conclusion

The accompanying Request for Continued Examination includes the appropriate filing fee as well as the fee for a one-month extension of time to respond to the Final Office Action filed October 20, 2005 (no further extension of time is required due to the fact that February 20, 2006, was a federal holiday). It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

As all claims in the application are believed to be in condition for allowance, Applicants request the application be allowed and passed to issuance as soon as possible. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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